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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,568	01/16/2002	Xavier Blin	05725.1018-00	1780

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 11/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary***File copy*

Application No.:

10/046,568

Applicant(s)

BLIN ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

Receipt is acknowledged of declaration, specification, IDS, preliminary amendment and claim for priority filed on 7/18/02, 8/9/02 and 4/29/02.

The preliminary amendment canceled claims 1-48 and added claims 49-105. Claims 49-105 are pending in the application and the status of the application is as follows:

#### *Priority*

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) for provisional application 60/330767 as follows:

1. The provisional application is filed in **French language** and applicants in the instant application provided translation of the provisional application. *The translation by the translator does not identify the **provisional application** at page 1.* Clarification and explanation is requested.
2. If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression “now Patent No. \_\_\_\_\_” should follow the filing date of the parent application. If a parent application has become abandoned, the expression “now abandoned” should follow the filing date of the parent application.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of

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four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

### **FOREIGN**

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

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*Specification*

5. The use of the trademark **Uniclear** at pages 11 and 27, **Versamid** and **Onamid** at page 11 and **UniRez** at page 13 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 49-59, 61, 65-78, 82-84, 86-88 and 92-98 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 4,655,836(836).

The instant application is claiming a structured nail polish composition comprising:

1. *At least one liquid organic phase comprising:*

*a. Volatile organic solvent*

*b. First polymer comprising;*

*i) A polymer backbone comprising hydrocarbon-based repeating units, wherein the e unit has one heteroatom*

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*ii) At least one fatty chain containing 6-12 carbon atoms and chosen from at least one pendent fatty chain and one terminal fatty chain where in the fatty chain is linked to the hydrocarbon-based units and is optionally functionalized*

*2. Second film-forming polymer (species is claimed in claim 74)*

*3. The organic phase additionally has non volatile oil*

*4. Additives in claim 88.*

The patent at col.2, discloses polyamides, which is claimed as “antislip agent”.

Applicants at page 12 disclose that the polymer can be polyamide resin. See col.2 for the ranges which overlap for the fatty chain, see col.6, lines 35-40, see col.1, lines 60-62 for the additives (claim 88, see col.3, lines 45 et seq for the volatile organic solvent. The solvents disclosed in the patent are volatile and therefore the patent anticipates claims 68-72, see claim 1 of the patent which has both the “nitrocellulose and polyamide resin” which reads on the claimed second film-forming polymer (claims 73-74). The preamble does not carry any patentable weight to claims as the claims are drawn to compositions. The polymer is the same and therefore the average molecular weight claimed inherent absence of evidence to the contrary. The expression comprising is inclusive of all the unrecited ingredients in major amounts.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 49-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of GB patent 2,196,978('978), U. S. Patent 6,402, 408 ('408).

The instant application is claiming a structured nail polish composition comprising:

1. *At least one liquid organic phase comprising:*
  - a. *Volatile organic solvent*
  - b. *First polymer comprising:*
    - i) *A polymer backbone comprising hydrocarbon-based repeating units, wherein the e unit has one heteroatom*
    - ii) *At least one fatty chain containing 6-12 carbon atoms and chosen from at least one pendent fatty chain and one terminal fatty chain where in the fatty chain is linked to the hydrocarbon-based units and is optionally functionalized*
2. *Second film-forming polymer (species is claimed in claim 74)*
3. *The organic phase additionally has non volatile oil*
4. *Additives in claim 88.*

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The patent '978 teaches ingredients 1a and 2-4 at page 2 and examples 1-2. The patent at page 3, lines 23-25 teach that the nail polish can be applied in a conventional applicator. The only difference between the patent and the application is the patent does not teach ingredient 2 in the nail/cosmetic compositions and in the form of a stick. However the patent '408 teaches 2 in the compositions as stick and its application in the field of nails. See cols. 3-4 for the polymer, which is the same, claimed in claim 62. See also col.7, lines 10-20 for the various additives, see the same column, lines 49-5- for the application on the nails, see also col.5 penultimate paragraph for the compositions in the form of stick, see col.6 lines 10-15, and 35 for the non-volatile oil.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '978 and combine it with the *polymer* of '408, expecting beneficial effect to the nail. The motivation to use the *polymer* stems from the teachings of '408 that the compositions provide glossy and non-migrating film when applied on the nails. The idea of combining the ingredients flows logically from the art for having been used in the same nail care art. ***Absent a showing the criticality of the polymer in the nail compositions Vs the example 1 of the GB patent giving un expected and superior results commensurate with the scope of claims***, the claims are rendered prima facie obvious over the combination of the patents.

11. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

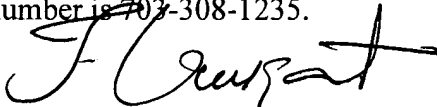


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
**JYOTHSNA A VENKAT**  
Primary Examiner  
Art Unit 1615

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November 4, 2002